

substituting display capabilities that exceed the capabilities of the multiple displays for the capability parameters. These substituted capabilities are then sent to the operating system of the computer. The specification clearly defines capability parameters as including display resolution, display pixel depth, or the refresh rate of the display (see page 6, lines 6 – 7). The specification also clearly defines the selected display capabilities as including monitor capabilities such as pixel resolution (see page 6, lines 22).

The Examiner contends that the first step of Applicant's invention corresponds to column 17, lines 2 – 33 (claim 1) of *Butler et al.* However, that passage does not state anything regarding receiving capability parameters such as resolution or pixel depth. Similarly, the Examiner contends that the second step of Applicant's invention corresponds to *Butler et al.* at column 10, lines 38 – 53. This passage discusses maximums of X and Y coordinates that define a bounding rectangle. This is in no way related to Applicant's second step of the present invention regarding substituting selected display capabilities, such as display resolution, for the initial capability parameters.

The Examiner additionally contends that Applicant's step of substituting the selected display capabilities that exceed the initially received capability parameters is disclosed by *Ishikura et al.* at column 1, lines 19 – 34. This passage of *Ishikura et al.* discloses moving a cursor out of the screen of a currently used display when the cursor "exceeds the display limits of the current screen". Applicant is unclear as to how this relates to Applicant's invention regarding "substituting selected display capabilities which exceed [the] display capabilities of each of the multiple displays for the capability parameters". The passage in *Ishikura et al.* refers to the X and Y coordinates of a cursor going beyond the edge of the screen while the alleged corresponding step of the present invention relates to substituting one set of display capabilities for another.

Recent court decisions have held that in order for prior art references to be combined by obviousness, at a minimum, there must be a suggestion of desirability for the modification. *In re Fritch*, 922 F.2d 1260, 23 USPQ 2d 1780 (Fed. Cir. 1992). Recently, a court has held that the motivating suggestion must be explicit. *Winner International Royalty Corp. v. Wang*, 48 USPQ 2d 1139 (D.C. Dist.Ct. 1998), *aff'd*, 98-1553 slip op. (Fed. Cir. 2000). *Butler et al.* and *Ishikura et al.* do not suggest desirability

for modification, explicit or otherwise. In fact, *Butler et al.* and *Ishkura et al.* neither teach nor suggest the present invention.


Since neither *Butler et al.* nor *Ishkura et al.* teach or suggest the present invention, it would not be obvious to combine the references. Additionally, even if the cited references were combined, the combination would not produce the present invention.

In the interest of clarity, Applicant has discussed only the differences described above between the art cited by the Examiner and the present claimed invention. The above-described differences do not represent all of the possible differences between the two.

For the above-stated reasons, Applicant believes that his invention is patentable over the prior art. Applicant respectfully requests that the Examiner allow the Applicant's invention as set forth in claims 1 - 26. No new matter has been added and no additional fee is required by this amendment. If the Examiner believes that a telephone conference with expedite prosecution, the Examiner is invited to contact the below listed attorney at the indicated number.

RESPECTFULLY SUBMITTED,

By: _____


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